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Atty. Dkt. No. 035451-0119

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Christopher

Title: SYNCHRONIZATION CRADLE WITH EXPANSION CARD SLOTS

Appl. No.: 09/847,509

Filing Date: 05/02/2001

Examiner: Datskovsky, Michael V.

Art Unit: 2835

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[**X**] Brief On Appeal (12 pages) (in triplicate).

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Respectfully submitted,

Date August 16, 2004 By Alistair K. Chan

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AUG 16 2004
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Christopher

Filing Date: 05/02/2001

For: SYNCHRONIZATION CRADLE WITH EXPANSION CARD SLOTS

Group Art Unit: 2835

Docket No.: 035451-0119

Application No.: 09/847,509

Examiner: Datskovsky, Michael V.

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BRIEF ON APPEAL

Mail Stop **APPEAL BRIEF - PATENTS**
Commissioner of Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

This paper is being filed in response to the final Office Action dated March 16, 2004 (finally rejecting Claims 1-4, 6, 9-13, and 15-39). The Notice of Appeal was filed on June 11, 2004 and received by the U.S.P.T.O. on June 14, 2004. Appellant respectfully requests reconsideration of the application.

Under the provisions of 37 C.F.R. § 1.192, this Appeal Brief is being filed in triplicate together with a check in the amount of $330.00 covering the Rule 17(c) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 06-1447.

REAL PARTY IN INTEREST

This application has been assigned of record to Palm, Inc. having a place of business at 5470 Great America Parkway, Santa Clara, California 95052. The assignment was recorded in the records of the United States Patent and Trademark Office at Reel/Frame 011776/0644 on May 02, 2001.

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RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

This is an appeal from the final Office Action dated March 16, 2004, finally rejecting Claims 1-4, 9-13, and 15-39. Claims 5, 7, and 14 were cancelled without prejudice in a reply dated May 5, 2003. Claim 8 was cancelled in a reply dated February 10, 2004. Claims 1-4, 9-13, and 15-39 are therefore on appeal.

STATUS OF AMENDMENTS

No claims have been amended subsequent to the mailing date of the final Office Action dated March 16, 2004.

SUMMARY OF INVENTION

The present invention relates to a synchronization docking station (120) for a handheld computer (130) (See Specification, paragraph [0116]). The synchronization docking station includes a data connection configured to communicate data from the docking station to the handheld computer (110). The synchronization docking station (120) also includes at least one expansion card connector (140) coupled to the docking station (120) and configured to communicate data between an expansion card (142) and the docking station (120) (See Specification, paragraph [0018]).

An exemplary embodiment relates to a system for storing and transferring data (100). The system includes a mobile electronic device (130) (See Specification, paragraph [0016]. The system also includes a personal computer (110). Further, the system includes a synchronization cradle (180) in communication with the personal computer (110) and the mobile electronic device (130). The synchronization cradle (120) includes at least one receptacle (140) for connecting an expansion card thereto (See Specification, paragraph [0018]).

Another exemplary embodiment relates to a computer system (400). The computer system includes a communications bus (412). The computer system (400) also includes a storage device coupled to the communications bus (412). Further, the computer system (400) includes a memory coupled to the communications bus (412) and a processor (416) coupled

to the communications bus (412). Further still, the computer system includes a synchronization cradle (420) for a handheld computer (440). The synchronization cradle includes at least one slot for accepting an expansion card (430, 432, and 434), and the synchronization cradle (420) is in communication with the communications bus (412) (See Specification, paragraph [0025]). Yet further still, the computer system (400) includes a program stored in the memory (414) and running on the processor (416) (See Specification, paragraph [0025]). The program is configured to display to a user a listing of the contents (230) of the expansion card (142) (See Specification, paragraph [0022]).

Yet another exemplary embodiment relates to a method of exchanging digital files between a memory device (350) and a computer (310). The method includes providing a synchronization device (320) for a handheld computer (330) (See Specification, paragraph [0023]). The synchronization device (320) includes at least one memory device connector (340). The method also includes coupling a memory device to the memory device connector. Further, the method includes running a program on the computer (310), the program configured to provide a user interface used (200) to transfer files. Further still, the method includes reading the digital files (230) on at least one of the memory device (350) and the computer and transferring at least one digital file.

ISSUES

One issue is presented in this appeal, and is concisely described in the following numbered paragraphs:

1. Whether Claims 1-4, 6, 9-13, and 15-39 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,392,447 to Schlack et al. in view of inherent functions of existing Windows Operating Systems.

GROUPING OF CLAIMS

The grouping of the claims is as follows:

Claims 1-4, 6, and 9-12 are grouped together as being directed to a synchronization docking station (120) for a handheld computer.

Claims 13 and 15-20 are grouped together as being directed to a system for storing and transferring data.

Claims 21-39 are grouped together as being directed to a computer system.

To the extent that the claims in these groups are argued separately below, the claims do not stand or fall together.

ARGUMENT

I. LEGAL STANDARDS

Claims 1-4, 6, 9-10, 13, 15-16, 20-26, and 28-39 have been rejected under 35 U.S.C. § 103(a), which states:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). "'[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the "factual inquiry whether to combine references must be thorough and searching." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ.2d 1001 (Fed. Cir. 2001). Further, it "must be based on objective evidence of record." In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination

obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

II. REJECTION OF CLAIMS 1-4, 6, 9-13, and 15-39 UNDER 35 U.S.C. § 103(a) OVER Schlack et al. in view of Windows.

In the final Office Action dated March 16, 2004, Claims 1-4, 6, 9-13, and 15-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schlack et al. in view of Windows.

For the reasons given below, the Appellant submits that the rejection of Claims 1-4, 6, 9-13, and 15-39 is improper and should be reversed.

A. The Examiner's Rejection of Claims 1-4, 6, 9-13, and 15-39 Should be Reversed Because There is No Suggestion to Combine the Teachings of Schlack et al. in view of Windows.

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references.

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 USPQ.2d 1788 (Bd. Pat. App. & Inter. 1986). In this case, the Examiner has not satisfied the burden of establishing that one of ordinary skill in the art would have been motivated to combine the teachings of Schlack et al. in view of Windows.

For example, in combining the teachings of Schlack et al. with those of Windows, the Examiner stated in the final Office Action dated March 16, 2004:

> It is inherent that existing Windows Operating System comprises features allowing user to create files indicating media areas (floppy disk, hard drive disk, e.g.,), names of the files and their content and

> enabling user to drag and drop files between different indicated areas.

While Windows may inherently provide some of the features of dragging and dropping files, it is unclear how this statement by the Examiner provides a motivation to combine the teachings of Windows with those of Schlack et al. Instead, this statement merely suggests that the functionality of Windows could be applied to the structure recited in independent Claims 1, 13, and 21 of a synchronization docking station (cradle) for a handheld computer or the method of exchanging data files of Claim 35.

The teachings of Schlack et al. do not provide that there is any need to transfer data from one card to another in the docking station. What is taught in Schlack et al. is that "memory cards located in the expansion slot 74 can be used to store data received from a facsimile conversion module 76, modem module 78 or personal computer 80 (PC) coupled to the docking station 70 when the main unit 10 is not located in the docking station 70. The memory cards are then transferred from the docking stage 72 to the main unit 10 to be accessed." See Schlack et al., column 11, line 61- column 12, line 3. Accordingly, Schlack et al. teaches away from the need for dragging and dropping one file from one card to another card while in the docking station. All that was conceived by Schlack et al. is that files from the PC could be transferred to the memory card in the docking station and then the card could be removed and placed in the electronic organizer. Accordingly, there is no motivation to combine the teachings of Schlack et al. with the teachings of Windows to arrive at Appellant's inventions of independent Claims 1, 13, 21, and 25. The Examiner has selected elements, from otherwise unrelated references, to make a combination that is unsupported by the actual teachings of such references. Instead, it appears that the combination of references relied upon by the Examiner is based on improper hindsight reasoning using the Appellant's own disclosure as a road map in an attempt to render the present claims obvious.

Further, nowhere in the inherent teachings of Windows is there teachings that files could be transferred between memory cards in a docking station. Windows may teach transferring of information from a peripheral device such as a disk drive or other memory device to a personal computer, however, there is no inherent teachings that Windows teaches transferring files between memory cards which are located in a docking station device.

Accordingly, the Appellant respectfully requests reversal of the rejection of Claims 1-4, 6, and 9-13, and 15-39 over the combination of Schlack et al. and Windows since the Examiner has not satisfied the initial burden of showing that one of ordinary skill in the art at

the time of the invention would have been motivated to combine the teachings of such references in the manner suggested by the Examiner.

CONCLUSION

In view of the foregoing, the Appellant submits that:

1. Claims 1-4, 6, 9-13, and 15-39 are not properly rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,392,447 to Schlack et al. in view of inherent teachings of Windows Operating Systems and are patentable.

Accordingly, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

Respectfully submitted,

Date August 16, 2004

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APPENDIX - THE CLAIMS ON APPEAL

1. A synchronization docking station for a handheld computer, comprising:

a data connection configured to communicate data from the docking station to the handheld computer; and

more than one expansion card connector coupled to the docking station and configured to communicate data between an expansion card and the docking station,

wherein the docking station includes a datalink configured to communicate data to a personal computer, and the personal computer includes a program configured to read the content stored on the expansion card, the program comprising a user interface, the user interface having an expansion card indicating area and an expansion card content area, the interface enabling drag and drop functionality to transfer expansion card content from one card to another card.

2. The synchronization docking station of claim 1, wherein the docking station is a synchronization cradle.

3. The synchronization docking station of claim 1, wherein the more than one expansion card connector is configured to communicate data between the expansion card and the handheld computer.

4. The synchronization docking station of claim 1, wherein the more than one expansion card connector is disposed within an expansion card slot, the expansion card slot being integrated into the docking station.

5. (Cancelled)

6. The synchronization docking station of claim 1, wherein the data link is a wireless link.

7. (Cancelled)

8. (Cancelled)

9. The synchronization docking station of claim 1, wherein the docking station includes a data link configured to communicate data to a communications network.

10. The synchronization docking station of claim 9, wherein the data link is a wireless link.

11. The synchronization docking station of claim 1, wherein the expansion card connector is configured to accept both secure digital (SD) cards and multimedia cards (MMCs).

12. The synchronization docking station of claim 1, wherein the expansion card connector is configured to couple to and provide power to a rechargeable battery pack.

13. A system for storing and transferring data, comprising:

a mobile electronic device;

a personal computer; and

a synchronization cradle in communication with the personal computer and the mobile electronic device, the synchronization cradle including more than one receptacle for connecting an expansion card thereto,

wherein the personal computer includes a program configured to display the contents of an expansion card located in the at least one receptacle, the program comprising a user interface, the user interface having an expansion card indicating area and an expansion card content area, the interface enabling drag and drop functionality to transfer expansion card content from one card to another card.

14. (Cancelled)

15. The system for storing and transferring data of claim 13, wherein the handheld computer includes a program configured to display the contents of an expansion card located in one of the more than one receptacle.

16. The system for storing and transferring data of claim 13, wherein the mobile electronic device is a handheld computer.

17. The system for storing and transferring data of claim 13, wherein the mobile electronic device includes a cellular telephone transceiver.

18. The system for storing and transferring data of claim 13, wherein the more than one receptacle is configured to receive both secure digital (SD) cards and multimedia cards (MMCs).

19. The system for storing and transferring data of claim 13, wherein the more than one receptacle is configured to receive and provide power to a rechargeable battery pack.

20. The system for storing and transferring data of claim 13, wherein the synchronization cradle is configured to communicate with the personal computer over a wireless link.

21. A computer system, comprising:

a communications bus;

a storage device coupled to the communications bus;

a memory coupled to the communications bus;

a processor coupled to the communications bus;

a synchronization cradle for a handheld computer, the synchronization cradle including more than one slot for accepting an expansion card and the synchronization cradle in communications with the communications bus; and

a program stored in the memory and running on the processor, the program configured to display to a user a listing of the contents of the expansion card, the program comprising a user interface, the user interface having an expansion card indicating area and an expansion card content area, the interface enabling drag and drop functionality to transfer expansion card content from one card to another card.

22. The computer system of claim 21, wherein the program is configured to display the name of files on the expansion card.

23. The computer system of claim 21, wherein the program is configured to display the size of files on the expansion card.

24. The computer system of claim 21, wherein the program is configured to display the type of the files on the expansion card.

25. The computer system of claim 21, wherein the program is configured to display the date the file on the expansion card was last modified.

26. The computer system of claim 21, wherein the program is configured to identify all of the expansion cards received in the more than one slot.

27. The computer system of claim 21, wherein the more than one slot is configured to accept both secure digital (SD) and multimedia cards (MMCs).

28. The computer system of claim 21, wherein the program enables selective transferring of files between the expansion card and the storage device.

29. The computer system of claim 21, wherein the program enables selective transferring of files between the expansion card and the handheld computer.

30. The computer system of claim 21, wherein the program enables selective transferring of files between more than one expansion card in the more than one slot.

31. The computer system of claim 21, wherein the expansion card includes an input/output device.

32. The computer system of claim 31, wherein the expansion card is a SD input/output (SDIO) card.

33. The computer system of claim 31, wherein the input/output device is a camera.

34. The computer system of claim 31, wherein the input/output device is a MPEG3 (MP3) player.

35. A method of exchanging digital files between a memory device and a computer, the method comprising:

providing a synchronization device for a handheld computer, the synchronization device including more than one memory device connector;

coupling a memory device to one of the memory device connectors;

running a program on the computer, the program configured to provide a user interface used to transfer files, the program comprising a user interface, the user interface having an expansion card indicating area and an expansion card content area, the interface enabling drag and drop functionality to transfer expansion card content from one card to another card;

dragging, on the user interface, a file in the content area associated with the memory device;

dropping, on the user interface, a file in the content area associated with one of another memory device and the computer;

reading the digital files on the memory device; and

transferring at least one digital file.

36. The method of claim 35, wherein the transferring step transfers a digital file between the computer and the memory device.

37. The method of claim 35, wherein the transferring step transfers a digital file between a first memory device and a second memory device.

38. The method of claim 35, further comprising:
coupling a handheld computer to the synchronization device.

39. The method of claim 38, wherein the transferring step transfers a digital file between the handheld computer and the memory device.